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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,274	03/19/2001	Samuel M. Babb	10992052-1	2356

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

NGO, HUNG V

ART UNIT	PAPER NUMBER
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2831

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/812,274

Applicant(s)  
Babb et al

Examiner  
Hung V. Ngo

Art Unit  
2831



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 36, 38, 39, 41, 42, 44, 46-48, 50, and 53-71 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36, 38, 39, 41, 42, 44, 46, 48, 50, and 53-71 is/are rejected.
- 7) ☒ Claim(s) 47 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### DETAILED ACTION

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 36, 38, 39, 41, 42, 44, 46-48, 50, 53-71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 36, line 5, 9, 15, 16, "circuit" is confusing. The examiner suggests --wiring--.

Claims 39, 44, 50, have similar problems as claim 36.

Claim 68, line 2, "composite resin" is not clearly understood.

Claims 38, 41, 42, 44, 46-48, 50, 53-67, 69-71 are included because of their dependencies.

#### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 36, 38, 39, 41, 42, 44, 46, 48, 50, 53-71 are rejected under 35 U.S.C. 102(b) as being anticipated by Chitwood et al.

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Chitwood et al discloses a printed wiring board (12); a plurality of components (20, 22, 24) mounted on said printed wiring board; and an electrically continuous conformal coating for providing an EMI-impervious shield conformingly and adheringly on the printed circuit board, including a conductive coating (34, 38) that prevents the electromagnetic waves from passing therethrough, said conductive coating conformingly and adheringly coating the surface of one or more regions of the printed circuit board, wherein said conductive coating of each said region is electrically connected to each other, and a dielectric coating (26) interposed between said conductive coating and predetermined portions of each said printed circuit board region, wherein said dielectric coating completely insulates said predetermined portions of said printed wiring board region and the conductive and dielectric coatings do not change substantially dimension of the printed wiring board (re claim 36).

Re claim 38, wherein said regions of said conformal coating are physically contiguous (Fig 3).

Re claim 39, wherein said printed circuit board comprises a plurality of grounding pads inherently mounted in said printed wiring board for connecting to components, wherein said conductive coating is connected electrically to said grounding pads (Fig 4), a ground plane (14), vias (col 2, line 51).

Re claim 41, a shield connector (32)

Re claim 42, a first region (top), a second region (bottom)(Fig 2)

Re claim 44, edge plating (14) see Fig 4.

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Re claim 46, first and second ground strip (14)(Fig 4), vias (col 2, line 51).

Re claim 48, signal traces (col 2, line 30-35) inherently having a desired characteristic impedance.

Re claim 50, see Fig 3.

Re claim 53, the dielectric coating made of thermosetting polymer (col 4, line 56).

Re claim 54, 57-62, 64-66 The presence of process limitations in product claims, which product does not otherwise patentably distinguish over prior art, cannot impart patentability to that product. In re Stephens 145 USPQ 656 (CCPA 1965).

Re claim 55, first layer (top surface), second layer (bottom surface).

Re claim 56, the dielectric coating of Chitwood et al is thixotropic (col 3, line 14-16)

Re claim 63, see col 2, line 68.

Re claim 67, see fig 3.

Re claim 68, the coating having similar structures (Fig 3).

Re claims 69, 70, see col 3, lines 20-25.

Re claim 71, one region (Fig 2), other region (Fig 3) are electrically connected.

***Allowable Subject Matter***

Claim 47 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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3. The following is an examiner's statement of reasons for allowance:

The limitation "spring clips" in combination with other limitations present is neither taught nor disclosed in the prior art of record.

*Communication*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung V. Ngo whose telephone number is (703) 308-7614. The examiner can normally be reached on Monday to Friday from 9:30 am to 06:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard, can be reached on (703) 308-3682.

The fax phone number for this Group is (703) 872-9318 (Before Final) or (703) 872-9319 (After Final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Hung V. Ngo

July 9, 2003

*Hung V. Ngo*

**HUNG V. NGO  
PRIMARY EXAMINER**